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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/268,412	03/15/1999	ALBERT J. SILVERA	31045-7	8401

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 11/20/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/268,412

Applicant(s)

SILVERA, ALBERT J.

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-9, 11, 15-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being obvious over "Creative Crystal" in view of "Skin Wear" tattoo and vice versa (herein after: Creative Crystal and Skin Wear). Creative Crystal teaches and suggests the application of artificial tattoos to the surface of shoes for decorating shoes. Creative Crystal is indefinite as to the type of artificial tattoos being used, and appears to be different from applicants disclosed tattoo. However, the artificial tattoo used by applicant is admitted prior art as disclosed in applicant's specification, paragraph bridging Pages 6-7, as a commercially available artificial tattoo, Skin Wear. In view of such artificial tattoo and the Creative Crystal's teachings, taken as a whole, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have substituted one type of artificial tattoo with another type of artificial tattoo to be used in Creative Crystal as an obvious alternative artificial tattoo for decorating shoes.

Alternatively, with respect to Skin Wear tattoo in view of Creative Crystal, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention

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to apply the Skin Wear tattoo to shoes as taught and suggested by Creative Crystal as an obvious alternative or added use for the Skin Wear tattoo.

As to applying the artificial tattoo to a smooth surface of the shoe, Creative Crystal is silent in this regard. However, the level of skill of attaching an artificial tattoo to a smooth surface or any surface that would accept such a tattoo is of such a low level that it would have been well within the skill of the ordinary skilled worker and would have been obvious at the time of applicant's invention.

With respect to the method claims, they are rendered obvious or inherent in the application of the commercially available Skin Wear tattoo in the combination, since the same artificial tattoo is being used by applicant, which requires wetting the tattoo and then applying the tattoo to the shoe surface (Claims 1 and 8).

As to method claim 5, removing a first applied tattoo and applying a second tattoo to the shoe, such would have been obvious and well within the skill of the ordinary skilled worker, if a first tattoo is desired to be replaced for whatever reasons.

As to the shoe surface being PVC, plastic, white, clear, or the smooth portion being stitched onto the shoe (claims 4, 6, 7, 15, 18, 21 and 22), these are common shoes features. It would have been obvious to use shoes having any of such features in the combination as an obvious alternative or matter of design choice. Similarly, to have the smooth portion match the size of the tattoo (claim 17) would also be an obvious matter of design choice well within the skill of the ordinary skilled worker if so desired.

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In response to applicant's request, Nadel et al. (5,577,828) and Drew (4,120,101) references are cited as examples that it is old and conventional to make shoes from transparent, clear PVC or plastic. Nadel '828 discloses a decorative panel (14) on footwear that is fabricated from either PVC and/or soft thermosetting or thermoplastic plastic material. Drew '101 discloses footwear where the plastic material of the upper is preferably a vinyl polymer, e.g. polyvinyl chloride (PVC).

3. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being obvious over Creative Crystal and Skin Wear as applied to claim 11 above, and further in view of Wasserman ('362). Creative Crystal and Skin Wear, as combined, teach the invention, except for locating the tattoo in a recessed portion of the shoe. Wasserman ('326) teaches and suggests locating and attaching a design element in a recess of a shoe (Figs. 1, 2 and 4). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to also apply the artificial tattoo of the combination in a recess of a shoe as taught and suggested by Wasserman ('326) as an obvious alternative location on a shoe for receiving a design. As to the dimensions of the recess (claims 13 and 14), they are deemed as obvious matters of design choices well within the skill of the ordinary skilled worker if so desired. Moreover, the dimensions have not been disclosed as being critical or serve any particular purposes.

Response to Arguments

4. Applicant's arguments filed August 26, 2002 have been fully considered but they are not persuasive. In response to applicant's argument denying the undeniable i.e. that shoes are not smooth, white/clear or made of PVC or plastic, Nadel et al. (5,577,828)

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and Drew (4,120,101) references are cited as examples that it is old and conventional to make shoes from transparent, clear PVC. Nadel '828 discloses a decorative panel (14) on footwear that is fabricated from either PVC and/or soft thermosetting or thermoplastic plastic material. Drew '101 discloses footwear where the plastic material of the upper is preferably a vinyl polymer, e.g. polyvinyl chloride (PVC).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, "Creative Crystal" teaches placing one or more of artificial tattoos on footwear, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have substituted one type of artificial tattoo with another type of artificial tattoo to be used in Creative Crystal as an obvious alternative artificial tattoo for decorating shoes.

In response to applicant's argument and the inventor's declaration that stick-on tattoos adhere better to smooth plastic or smooth PVC surfaces, the level of skill of attaching an artificial tattoo to a smooth surface or any surface that would accept such a tattoo is of such a low level that it would have been well within the skill of the ordinary skilled worker and would have been obvious at the time of applicant's invention. Furthermore, the fact that applicant has recognized another advantage which would

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flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is 703-305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Jila M. Mohandesi
Examiner
Art Unit 3728

JMM
November 5, 2002

A handwritten signature in black ink, appearing to read 'Mickey Yu', is positioned above the printed name and title.

Mickey Yu
Supervisory Patent Examiner
Group 3700